

Remarks

Newly presented claims 59-76 are based on the allowed claims in Serial No. 08/943,125 filed October 3, 1997, and the first full paragraph on page 20 of the written description of in Serial No. 08/943,125. Serial No. 08/943,125 is based on the same original application as the parent application in this case. The examiner indicated in Serial No. 08/943,125, that she found claims 45-48, 51-54 and 57, 58 allowable over the prior art. Applicant attaches the office action in Serial No. 08/943,125 indicating this. Newly presented claims 59-76 correspond to these claims.

Applicant points out that in lieu of the multiple dependent claim format of old claim 58 in Serial No. 08/943,125, the present amendment sets out corresponding new claims 81-84 in a conventional independent claim format, but include the same number of claims as old claim 58.

Applicant has added cadmium oxide and lead monoxide to the category of solid lubricants in claims 60 and 64. The application supports these amendments at page 16 second full paragraph and third full paragraph respectively. The amendment adds claims 68-79 relating to a method of the invention where the lubricant comprises the chalcogenides of non-noble metals and mixtures thereof, such as the chalcogenides of molybdenum, antimony, niobium, and tungsten, and mixtures thereof, or sulfides of these metals, and mixtures thereof. The application supports these claims at page 24, third paragraph, page 25, first and second paragraphs, and page 26 first paragraph.

Newly added claim 80 relates to the combination of a grease lubricant with the superabsorbent polymer. The application supports claim 80 at pages 13-14.

Claims 81-84 relate to substantially anhydrous compositions of the present invention, supported by page 29, second paragraph of the written description.

Applicant requests the examiner to consider the foregoing claims and the references cited in the Information Disclosure Statement submitted with this preliminary amendment. Applicant also cited these references in the parent application. The claims are distinguishable from the references for the same reasons the examiner indicated that claims 45-48, 51-54 and 57, 58 in Serial No. 08/943,125 were distinguishable. Again, applicant has attached a copy of the examiner's reasons for finding these claims distinguishable. These claims are also distinguishable for the reasons advanced by the applicant during the prosecution of Serial No. 08/943,125. All of these reasons apply to the claims in this application as well.

The examiner, however, rejected claims 45-48, 51-54 and 57, 58 in Serial No. 08/943,125 on the grounds of provisional obviousness-type double patenting in view of the invention claimed in application Serial No. 08/943,123 which has now been allowed and the issue fee paid. Application Serial No. 08/943,123 has not yet issued as a United States Patent, but in order to address the rejection applicant has filed a Terminal Disclaimer with the present application.


37 C.F.R. § 1.53 (b) Divisional Application of
Parent Application, Serial No. 08/943,123
Preliminary Amendment
February 18, 2004

CONCLUSIONS

Applicant requests the examiner to pass the present claims to issue in view of
the foregoing amendments and remarks.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

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Dated: February 18, 2004

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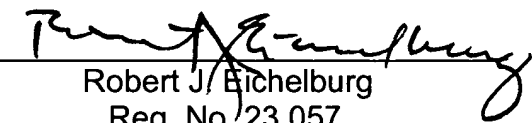
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EXAMINER

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ART UNIT PAPER NUMBER

1714

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20030925

Application Number: 08/943,125
Filing Date: October 03, 1997
Appellant(s): LEVY, RICHARD

Robert J. Eichelburg

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 13, 2003.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The rejection of claims 45-48, 51-54 and 57-58 under 35 U.S.C. section 103(a) is withdrawn in view of applicant's detailed and convincing arguments presented in the appeal Brief dated March 13, 2003. The said claims 45-48, 51-54 and 57-58 are now objected to for depending on claims that are rejected under the Section of 35 U.S. C. 103 (a).

(7) Grouping of Claims

Appellant's brief includes a statement that claims 43-58 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO 93/18233	Geursen et al (Geursen)	09-1993
U.S. 5,534,304	Geursen et al (Geursen)	07/1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43, 44, 49, 50, 55 and 56 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Geursen et al (Geursen) WO 93/18233 that has matured into its US Counterpart 5,534,304.

Geursen teaches and discloses a method for coating a substrate e.g. fiber or a fibrous product, page 5, lines 19-20, which includes substrates to be treated selected from the group of polyester, aliphatic polyamide, cellulose, polyolefin, polyacrylonitrile, carbon, glass and metal, note claim 6, with a layer of a water-in-oil emulsion which contains a superabsorbent material (SAP) in its aqueous phase, page 5, lines 21-24. Patentees further teaches that the (SAP) includes water-soluble or water-insoluble material having hydrophilic properties which is capable of absorbing and holding a comparatively large quantity of water, optionally under pressure, page 6, lines 5-32.

Geursen incorporates the teachings of Arroyo et al (Arroyo) EP 0,351,100 that the SAP includes the ARIDALL polymers that are known to absorb greater than 100 times its weight in water. Appellant makes admission on record at page 21 to the bridging paragraph of pages 22-23 of the instant specification that conventional known SAP that absorb greater than 100 times its weight in water of the Admitted Prior Art are the SAP used in the instant claims. Appellant makes admission on record at line 17 of the instant specification that the ARIDALL POLYMERS of the Admitted Prior Art of Arroyo is the SAP used in the instant claims.

The examiner takes the position of record that the lubricant additive of the instant claims is an optional component and therefore is not required. Geursen further teaches that commercially available water-in-oil emulsions which contain a SAP maybe employed in combination with additives such as lubricants, stabilizers, emulsifiers and/or diluents, page 8, lines 5-10. Geursen further teaches ethoxylated oleyl alcohol and ethoxylated oleic acid having use as emulsifiers and as lubricant, page 8, line 12-14 and that the diluents include non-aromatic naphthenic and (iso) paraffinic hydrocarbons, page 8, lines 15-18. The stabilizers incorporated into the emulsions of Geursen include sorbitan trioleate, mixtures of sorbitan trioleate and ethoxylated sorbitan trioleates, sorbitan mono(iso)stearate, and sorbitan mono-oleate, page 8, lines 27-29. Geursen further teaches at page 9, lines 6-8 that if so desired, the water-in-oil emulsions may contain the conventional additives such as bactericides and antioxidants.

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Patentees teaches that the water-in-oil emulsion may be applied using methods known in the art, page 9, lines 11-13, leaving a homogenous layer of SAP on the substrate, page 9, lines 23-26 and Example I, pages 15-18. It is the examiner's position that the instant claims are directed to a method of lubricating by coating a substrate. It is known in the lubricant art that the lubrication composition has to be applied as a coating or be in contact with a surface in order to exhibit its lubricating properties. Thus the teachings of Geursen anticipate the methods of lubricating by coating a substrate of the instant claims.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 72-86 of co-pending Application No. 08/943,123. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claimed method for lubricating a surface containing the same composition and the one step of coating a

surface that is not patentable distinct from related application 08/943,123 method for control lubrication by coating a surface with one a one step process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(11) Response to Argument

Appellant's arguments directed to the rejection of claims 43, 44, 49, 50, 55 and 56 under 35 U.S. C. Section 102 (b) as anticipated by Geursen is unpersuasive because the arguments are not commensurate in scope with the breath of the instant claims. The instant pending claims as drafted are not specific to any substrate and encompass the substrate of the relied on prior art. The arguments presented in the Appeal Brief are directed to the swell index of the of the fiber along with the SAP wherein the instant claims are only directed to the property of the SAP having the ability to absorbs greater than about 100 times its weight in water. The SAP of Geursen clearly have the ability to absorb from 50 to 700 or higher, more particularly from 100 to 700 or higher its weight in water, note the bridging paragraph of pages 12-13.

It is further noted that appellant's arguments set forth on pages 4-5 of the Appeal Brief is related to the background of Geursen and is not the teaching of the invention of patentee. Therefore, the argument is unpersuasive because Geursen clearly teaches that their SAP are derivatives of polyacrylic acid and that the said SAP are rendered insoluble in water by ionic and/or covalent cross-linking, note the second full paragraph of page 6, particularly the last two lines.

Preferably, Geursen makes use of a terpolymer of acrylamide and carboxyl groups- and sulfo groups-containing monomers (sodium salt) or, of a polyacrylamide copolymer, the Mirox W 45985 of Example 1, note pages 16-17. Appellant's' arguments set forth on pages 6-12 of the Appeal Brief are further directed to the same issues with to Geursen addressed above. The said arguments are rebutted by the teachings of Geursen set forth supra.

Appellant's arguments set forth on pages 12-19 of the Appeal Brief directed to the rejection set forth under 35 U.S.C.103 are deemed moot in that the said rejection has been withdrawn.

The examiner maintains the position stated of record that claims 43-57 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of claims 72-86 of co-pending application Serial No. 08/943,123 for reasons made of record. Other than the preamble of the related case the claims of both applications involve a one step process for lubricating a surface.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,
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Margaret B. Medley
Primary Examiner
Art Unit 1714

MBMedley
September 25, 2003

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